



UNITED STATES PATENT AND TRADEMARK OFFICE

CP

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/267,639

03/15/1999

TAKU KATOH

04329.2078

7338

22852

7590

09/25/2006

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP

901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

CALLAHAN, PAUL E

ART UNIT

PAPER NUMBER

2137

DATE MAILED: 09/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/267,639

Applicant(s)

KATOH ET AL.

Examiner

Paul Callahan

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14,15 and 17-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14,15,19,21 and 22 is/are rejected.
- 7) ☒ Claim(s) 17, 18, 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. Claims 14, 15, and 17-23 are pending in this application and have been examined.
2. The indicated allowability of claims 15, 19, and 23 as found in the previous Office Action is withdrawn in view of the newly discovered reference(s) to Kuroda et al., US 6,792,538 (henceforth Kuroda). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Art Unit: 2137

5. Claims 14, 21, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Kuroda.

As for claim 14, Kuroda teaches method of embedding identification information in a main body of data of a digital record medium (fig. 2, items S1-S8), comprising: error correction encoding digital data to correct an error occurring during transmission of the main body of data (abstract, col. 11 lines 24-43), embedding, based on position information, the identification information in a part of the main body of data upon which the error correction encoding has been performed (col. 11 lines 24-43), embedding the position information after embedding the identification information (col. 11 lines 24-43), and storing the main body of data including the embedded identification information and the embedded position information into the digital record medium (col. 11 lines 24-25: "second record medium").

As for claim 21, Kuroda teaches a method of extracting identification information from a main body of data of a digital record medium (col. 12 lines 19-25), the main body of data including embedded identification information and position information comprising (col. 12 lines 1-8, 19-25), reading the main body of data from the digital record medium (col. 11 lines 54-63), extracting the identification information from the main body by an error correction decoding based on the position information col. 12 lines 7-8), and error correction decoding the main body of data after extracting the identification information in which original digital data is obtained (col. 12 lines 19-25).

As for claim 22, Kuroda teaches a method of embedding identification information in a main body of data of a digital record medium by using an error correction technology (fig. 2 items S1-S8), comprising: encrypting digital data by using the identification information (col. 12 lines 47-53, 65-67), error correction encoding the encrypted digital data including digital contents to correct an error occurring during transmission of the main body of data (col. 12 lines 47-53), embedding, based on position information, the identification information in a part of the main body of data upon which the error correction encoding is performed (col. 14 lines 9-25), embedding the position information in a part of the main body of data upon which an the error correction encoding is performed (col. 14 lines 9-34); and storing the main body of data, including the embedded identification information into the digital record medium (col. 14 lines 35-45) .

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 15, 19, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda.

As for claims 15 and 23, Kuroda fails to explicitly teach a step of embedding identification information to a data part stored in an area where control information of contents data in a record area is recorded. However Official Notice may be taken that this is a step that is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this step into the system of Kuroda. It would have been desirable to do so since such localization of identification data within such control data area would present the advantage of decreasing the chance of degradation of the main body of data by such watermarking.

As for claim 19, Kuroda fails to explicitly teach position information in a table form. However Official Notice may be taken that such a feature is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this step into the system of Kuroda. It would have been desirable to do so since such a table form would allow embedding of a watermark in regions of an image localized in a two dimensional spatial manner.

Allowable Subject Matter

8. Claims 17, 18, and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter: The closest prior art in the field, Kuroda, does not teach the combination of features set forth in the claimed invention, particularly including:

As per claims 17 and 18, identification information that has a plurality of partial identification information,

As per claim 20, presentation target data that is scrambled or encoded to make the identification information a key before an error correction encoding is performed.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Emmanuel Moise, can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is: (571) 273-8300.

9-16-06

Paul Callahan

A handwritten signature in cursive script, appearing to read "Paul Callahan", written in black ink.